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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/879,825 | 06/12/2001 | Craig W. Barnett | 031792-0311564 | 4591 |
| 909 | 7590 | 10/24/2008 | | |
| PILLSBURY WINTHROP SHAW PITTMAN, LLP | | | EXAMINER | |
| P.O. BOX 10500 | | | DURAN, ARTHUR D | |
| MCLEAN, VA 22102 | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|---------------------------------------|
| Office Action Summary | Application No. 09/879,825 | Applicant(s) BARNETT ET AL. |
| | Examiner Arthur Duran | Art Unit 3622 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 07 October 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 47-51,53-55,57,59,61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 47-51 and 53-55, 57, 59 and 61, 62 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/GS/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claims 47-51 and 53-55, 57, 59 and 61, 62 have been examined.

Response to Amendment

The Amendment filed on 10/7/2008 is insufficient to overcome the prior rejection. Also, please note the BPAI Decision on Appeal dated 8/21/2008. Also, please note the Response to Arguments section below.

Claim Rejections - 35 USC § 112

Claim 47-51 and 53-55, 57, 59 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regards to independent claim 47, Examiner can find no support for the features of "said electronic coupon includes data representative of the identity of a location at which additional coupon information resides".

In regards to claim independent 57, Examiner can find only minimal support for the features of "establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon". Barnett does not disclose any authentic, authorize, valid or invalid steps or servers related to coupon redemption. The closest Examiner could find was validating the user's id against valid members ([91] of the PG Pub for this Application). Other than that, these words (authentic, authorize, valid or invalid) do not exist in the Applicant's Specification. Also, Examiner could not

find where the Applicant's Specification discloses separate subsequent server and authentication server.

Claim Rejections - 35 USC § 103

Claims 47-51 and 53-55, 57, 59 and 61, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger (4,882,675) in view of Valencia (5,380,991).

Claims 47, 57: Nichtberger discloses a system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a client system, said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel (col 5, lines 1-16; col 11, lines 40-50; col 30, lines 1-6);

said client system including associated memory, said client system being adapted for storing said electronic coupon in said memory (col 30, lines 1-6);

a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon (col 30, lines 1-6).

Nichtberger further discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

Also, Nichtberger (col 30, lines 1-6) and Valencia (col 7, lines 41-49) disclose that the client system stores electronic coupon in said memory.

Additionally, in Nichtberger (col 30, lines 1-6) it is implied that the coupon information in the first server system is transmitted to the client system, which is the card. That the coupon information is transmitted is implied because the coupon information is stored electronically on both the first server system and the client system. And, the information is 'recorded' on the second client system. Hence, the information must be transmitted in order to be recorded in a device where the information had not been.

Also, Nichtberger discloses that there are multiple server systems that interact with the client system for coupon distribution and redemption (Fig. 1, item 10; Col 4, lines 41-47). Hence, the user utilizing the client system can be transmitted coupons at

one location by a first server system and redeem coupons at a different location by a second or different server system.

In regards to the combination of Nichtberger and Valencia, Nichtberger discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

In further regards to claim 47, Nichtberger discloses that said electronic coupon includes data representative of the identity of a location at which additional coupon information resides (col 28, lines 15-30). Note that Nichtberger discloses that a coupon can link to more information that is relevant to the coupon or the item that the coupon is for (nutritional, recipe information, etc).

In further regards to claim 57, the combination of the prior art renders obvious the steps of establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon.

Nichtberger discloses coupons with parameters and expiration dates (Fig. 9; col 9, lines 20-25). Nichtberger further discloses presenting coupons at time of purchase and the terminal server system authorizing the coupons (Fig. 4, item 64, "Purchases compared to coupon selections" and the next step, item 76, "Discounts applied"; col 17:49-60). Nichtberger further discloses multiple server systems (Fig. 1 and the Decision on Appeal dated 8/21/2008). Nichtberger further discloses the terminal server system (Fig. 4, item 78) communicating with the central server system (Fig. 4, item 16) and the central server system confirming the coupon redemption (Fig. 4, item 82, 84, 80, 86). Nichtberger does not explicitly disclose that the authorizing of the coupon at time of coupon use occurs by a central server system or server system that is remote from the terminal server system.

However, Valencia discloses the authorizing of the coupon occurs by a second server system or server system that is remote from the store server system at time of coupon use (7:50-8:15; 9:40-50). Note that Valencia discloses that the terminal server and/or central computer server can authorize the coupon at time of use.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's central server coupon authorization to Nichtberger's terminal coupon authorization and central server. These features of the

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claimed invention are merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 61, 62: Examiner notes that independent claims 61 and 62 are similar to independent claims 47 and 57 and 63 dated 8/21/2008. And, the rejection of claims 47, 57, and 63 was Affirmed by the BPAI on 8/21/2008. Over independent claims 47 and 57, Claims 61 and 62 includes the additional features that the client system can be remote from the server system. However, claim 63, dated 8/21/2008, included that the client system can be remote from the server system. And, the BPAI affirmed the rejection of these features on pages 31-34 of the Decision on Appeal dated 8/21/2008. Please see those pages.

Also, the rejection of these remote client features is stated below.

Nichtberger and Valencia disclose a system according to claim 47 and 57 above. Additionally, claims 61 and 62 include the features that the client system can be remote from the server system.

And, Nichtberger further discloses that the coupon includes a data component (col 19, lines 34-39; col 22, lines 1-9), that the communications channel operates over a network which can be expansive and operate over remote areas (col 32, lines 1-8; Fig. 1; col 15, lines 25-30; col 12, lines 8-15; col 3, lines 18-25, "to provide a system in which a customer selects coupons at home or upon entering a particular store).

Hence, Nichtberger renders obvious that the client system can be remote from the server system.

Also, note that claim 61 and 62 did not state that the network was TCP/IP or Internet based. So, the rejection of claim 61 and 62 did not need the Cameron reference as was used in the Affirmed rejection of claim 63 dated 8/21/2008. Also, Examiner notes that the Decision on Appeal affirmed that the Nichtberger discloses utilizing a network (top of page 28 of Decision on Appeal; Nichtberger, Fig. 1, col 15:25-30; 12:8-15).

Claim 48, 59: Nichtberger and Valencia disclose a system according to claim 47, 57, Nichtberger further discloses:

a third server system connected to said communications channel, said third server system being adapted for communicating with said second server system and for authorizing the redemption of said electronic coupon (Fig. 4; col 17, lines 49-60).

Claim 49: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon as a function of a transaction initiated between said client system and said second server system (Fig. 4).

Claim 50: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon by modifying a transaction initiated between said client system and said second server system (Fig. 4).

Claim 51: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said communications channel includes a network (Fig. 1; col 15, lines 25-30; col 12, lines 8-15).

Claim 53: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said first server system and said second server system are the same server system (col 5, lines 1-5).

Claim 54: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said electronic coupon is a token issued under the authority of an issuer for the benefit of said client (col 30, lines 17-30).

Claim 55: Nichtberger and Valencia disclose the system according to claim 47, and Nichtberger further discloses that said electronic coupon includes data representative of one or more of a serial or identification number, a validation key, an authentication key, an authorizing vendor, a redeeming vendor, a benefit or discount to be associated with a transaction, a level of access granted, and an issuing activity (col 30, lines 17-30; col 19, lines 34-39; col 22, lines 1-9).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive.

Also, please note the BPAI Decision on Appeal dated 8/21/2008 where the rejections were affirmed in part.

Examiner notes that the 35 USC 103 rejection of all features for the current copy of the claims dated 10/7/08, except the following, were affirmed as properly rejected by

the BPAI on 8/21/2008. Hence, the affirmation of the rejection of those features is now part of the case history on this application. And, only the features that were not affirmed by the BPAI as properly rejected need be demonstrated as obvious by this Office Action.

The features which were not affirmed by the BPAI are:

"said electronic coupon includes data representative of the identity of a location at which additional coupon information resides" (now in claim 47); and

"the steps of establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon" (now in claim 57).

Examiner has found new citations, not presented to the BPAI before, from the same Nichtberger and Valencia reference that are relevant to these two features (which were added to claims 47 and 57). Hence, the same rejection has been utilized with the addition of citations to better address these two features.

Also, upon further inspection of these two features and the Applicant's Specification, Examiner has added a 35 USC 112 rejection concerning these features. Please see the above 112 rejection.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Saigh (5,734,823) discloses many relevant features for electronic coupons and websites and electronic coupon issuing and redemption.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
Art Unit 3622

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10/21/2008